

## REMARKS

### **I.     Introduction**

Claims 1 and 5 to 12 are pending in the present application. Claim 1 has been amended in view of the Examiner's comments. Since no new issue is raised by the amendment, entry of the amendment is requested. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II.    Rejection of Claims 1, 5, 7 to 12 under 35 U.S.C. § 112, ¶ 2**

Claims 1, 5 and 7-12 are rejected under 35 U.S.C. §112, ¶ 2, as being indefinite. Specifically, with respect to claim 1, the Examiner contends that the feature "seamlessly enclosed to" is "unclear" and "not necessary" in view of the additional recitation that "the one-piece cooling tube is formed of a single structural component without joining seams." The Examiner has also asserted that "for the purposes of examination the claim [1] will read: . . . 'wherein the cooling tube is completely enclosed along the length of the bottom section.'"

In view of the Examiner's comments, Applicants have removed the phrase "seamlessly enclosed to." With respect to the Examiner's asserted interpretation of claim 1 "for the purposes of examination," Applicants note that the asserted interpretation is narrower than the meaning sought to be presented by Applicants; instead, claim 1 has been amended to more clearly convey the Applicants' intended meaning, i.e., "wherein an interior channel of the one-piece cooling tube is enclosed relative to the bottom section."

In view of the amendments, Applicants respectfully request that the indefiniteness rejection be withdrawn.

### **III.   Rejection of Claims 1, 5 and 7-12 under 35 U.S.C. § 103(a)**

Claims 1, 5 and 7-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,302,190 ("Clamp") in view of United States Patent No. 6,442,023 ("Cettour"). For at least the following reasons, Applicants respectfully submit that pending claims 1, 5 and 7-12 are patentable over Clamp.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

In support of the rejection, the Examiner contends in the “Response to Arguments” section of the Office Action the following: (1) “the present rejection does not rely on Cettour to teach the cooling tube being completely enclosed along the back plate”; (2) “this is already taught by the Clamp reference”; (3) “Cettour reference is merely being used to teach the conventionality of making such a cooling tube structure integral or seamless as claimed”; (4) “the only difference between the invention presently claimed in claim 1 and the Clamp reference is that the back plate (34) and cooling plate (30) are all seamless (i.e., one piece or integral)”; and (5) “Cettour teaches making a cooling tube (22) integral with a plate (2).” However, the Examiner’s contentions are not only factually incorrect, but legally deficient to the extent the Examiner is selectively picking the individual claimed elements from the individual applied references, without any regard to the overall teachings of the applied references as a whole, as explained in further detail below.

First, to the extent the Examiner contends that “the cooling tube being completely enclosed along the back plate . . . is already taught by the Clamp reference,” and that “Cettour reference is merely being used to teach the conventionality of making such a cooling tube structure integral or

seamless as claimed,” the Examiner’s rationale is critically flawed in that neither reference teaches a “one-piece cooling tube integrally formed in the bottom section . . . , wherein an interior channel of the one-piece cooling tube is enclosed relative to the bottom section, and wherein the entire bottom section including the one-piece cooling tube is formed of a single structural component without joining seams.” To the extent the Examiner is contending that incorporation of the cooling channel 22 of Cettour into the cooling plate 30 of Clamp would somehow satisfy the present claimed limitation, this is clearly incorrect: in Cettour, the cooling channel 22 extending through component 2 have numerous holes, which means the combined apparatus would not satisfy the above-recited claimed limitation.

Second, to the extent the Examiner is implicitly suggesting that it is permissible to selectively ignore the clear teaching in Cettour that the cooling channel 22 extending through component 2 have numerous holes, this is clearly impermissible: a prior art reference much be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP 2143.02 VI. Accordingly, in view of the specific teaching in Cettour that the cooling channel 22 extending through component 2 have numerous holes, the overall teachings of Clamp and Cettour clear cannot suggest the claimed feature that “an interior channel of the one-piece cooling tube is enclosed relative to the bottom section.”

Third, to the extent the Examiner is contending that one of ordinary skill in the art would be somehow motivated to incorporate the cooling tube 22 of Cettour into the arrangement of Clamp, this asserted modification does not make any sense: there is simply no logical reason why one of ordinary skill in the art would consider the incorporation of the component 2 of Cettour into the arrangement of Clamp, particularly since the cooling channel 22 formed in component 2 of Cettour is an open channel with numerous holes, whereas the 2-piece cooling channel disclosed in Clamp is a closed channel.

Fourth, to the extent the Examiner contends that “[t]he Cettour reference is merely being used to teach the conventionality of making such a cooling tube structure integral or seamless as claimed,” and that “Cettour . . . teaches making a cooling tube (22) integral with a plate (2),” the Examiner is characterizing element 2 of Cettour as being equivalent to the claimed “entire bottom section,” which is clearly incorrect. In this regard, the claimed “bottom section” is defined in claim 1 as being “configured to be affixed to a circuit board.” Element (2) of Cettour in no way meets this limitation, since element (2) connects with element (5) to have fluid run over/through it. It is

only side (4) of part (1) that is “configured to be affixed to a circuit board.” Thus, as clearly illustrated in Cettour, two clipped and fastened pieces, i.e., element (1) and element (2), are required to form “a bottom section configured to be affixed to a circuit board,” and “a cooling tube.” Since the fastening of these two pieces creates a seam between them, Cettour clearly fails to disclose the feature of “wherein the entire bottom section including the one-piece cooling tube is formed of a single structural component without joining seams.” Since neither Clamp nor Cettour disclose a “bottom section including [a] one-piece cooling tube [that] is formed *of a single structural component without joining seams*,” Applicants respectfully request the rejection be withdrawn, since at least this claim feature is not disclosed by any cited reference.

For at least the foregoing reasons, Applicants submit that claim 1 and its dependent claims 5 and 7-12 are not rendered obvious by Clamp and Cettour.

#### **IV. Rejection of Claim 6 under 35 U.S.C. § 103(a)**

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,302,190 (“Clamp”) in view of United States Patent No. 6,442,023 (“Cettour”) in further view of U.S. Patent 4,652,970 (“Watari”). For the following reasons, Applicants respectfully submit that claim 6 is patentable over the combination of Clamp and Watari.

Claim 6 depends on claim 1. As noted above, the overall teachings of Clamp and Cettour clearly do not suggest every feature of parent claim 1. In addition, Watari clearly does not remedy the deficiencies of Clamp and Cettour as applied against parent claim 1. Accordingly, even if one assumed for the sake of argument that some motivation existed for combining the teachings of Clamp, Cettour and Watari, with which assumption Applicants do not agree, the overall teachings of Clamp, Cettour and Watari would not render obvious claim 1 and its dependent claim 6. Therefore, the obviousness rejection of claim 6 should be withdrawn.

**CONCLUSION**

For the foregoing reasons, it is respectfully submitted that all pending claims 1 and 5 to 12 of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

KENYON & KENYON LLP

 (R. No. 36,197)

Dated: 11/5, 2009

By: SONG LEE for Gerard Messina

Gerard A. Messina

Reg. No. 35,952

One Broadway

New York, New York 10004

Telephone: (212) 425-7200

Facsimile: (212) 425-5288

**CUSTOMER NO. 26646**